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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/974,911	10/12/2001	Harold Ferdinand Van Garderen	0142-0362P	8931

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EXAMINER
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TANG, KENNETH

ART UNIT	PAPER NUMBER
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2195

DATE MAILED: 11/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/974,911	<b>Applicant(s)</b> VAN GARDEREN ET AL.	
	<b>Examiner</b> Kenneth Tang	<b>Art Unit</b> 2195	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 08 September 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. Applicant's arguments, see Remarks, filed 9/8/06, with respect to the rejection(s) of claim(s) 1-4 under Popat et al. (hereinafter Popat) (US 6,678,415 B1) in view of Hoshino (US 6,868,189 B1) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Whitmarsh et al. (US 7,042,585 B1).
2. Claims 1-5 are presented for examination.

### *Claim Rejections - 35 USC § 101*

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 1-5 are directed to non-statutory subject matter. The claimed invention as a whole must be useful and accomplish a practical application. That is, it must produce a "useful, concrete and tangible result." State Street, 149 F.3d at 1373-74, 47 USPQ2d at 1601-02. The purpose of this requirement is to limit patent protection to inventions that possess a certain level of "real world" value, as opposed to subject matter that represents nothing more than an idea or concept, or is simply a starting point for future investigation or research (Brenner v. Manson, 383 U.S. 519, 528-36, 148 USPQ 689, 693-96 (1966)); In re Fisher, 421 F.3d 1365, 76 USPQ2d 1225 (Fed. Cir. 2005); In re Ziegler, 992 F.2d 1197, 1200-03, 26 USPQ2d 1600, 1603-06 (Fed. Cir. 1993)).
4. Specifically, in claim 1, line 14, it is claimed that paths presented are suitable to carry out the job. However, in the claim language, the job is not necessarily being executed or carried out

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but rather is only suitable to carry out the job. The actual job execution is the tangible result needed to comply with 35 USC 101 but is lacking in the claim language. Claims 2-5 also do not contain a tangible result. The limitations of claims 1-5 do not claim carrying out the job execution.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 1, it is unclear whether it is a system claim or a means plus function claim.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. **Claims 1-3 and 5 are rejected under 35 U.S.C. 102(e) as being anticipated by**

**Whitmarsh et al. (hereinafter Whitmarsh) (US 7,042,585 B1).**

7. As to claim 1, Whitmarsh teaches a distributed document handling system for carrying out jobs, where jobs are carried out by services distributed over a network and where a job leads to a product, the system comprising:

a pool of services, the services being distributed over a number of interconnected processing devices (col. 5, lines 1-9);

specifying means for entering by a user a job specification comprising product specifications specifying the product to be delivered by the job and specifications specifying circumstantial constraints without effect on the product (wherein price is attribute), in considering selection from the pool of services (col. 10, lines 9-21 and 59-65, col. 11, lines 22-39, col. 5, lines 48-61);

determining means for determining a path of services, the services being selected from the pool of services, wherein the path is suitable to carry out the job in accordance with the product specifications, and wherein the determining means is operable to take into account circumstantial constraints for that job (paths are determined based on price and are sorted or ranked based on price) (col. 11, lines 31-39).

user interface means for presenting the paths suitable to carry out the job (col. 4, lines 49-67, col. 5, lines 1-9, Fig. 2, items 24 and 46);

user interface means for, after the paths have been presented, enabling modification of the job specification by the user (attributes are entered via user interface and can be changed dynamically) (col. 5, lines 48-61, col. 11, lines 14-39); and

means for, upon modification of the job specification, involving the determination means again for determining a path of services, based on the modified job specification (col. 5, lines 48-61, col. 11, lines 14-39).

8. As to claim 2, Whitmarsh teaches the distributed document handling system wherein:

a circumstantial constraint defines a limit in an ordered range (col. 11, lines 23-24); the system also comprises:

means for ranking paths suitable to carry out the job in accordance with the ordered range of the circumstantial constraint (col. 11, lines 23-39); and

user interface means for selection by the user of a desired job specification from a ranked list of job specifications based on the ranked paths (col. 10, lines 9-21 and 59-65, col. 11, lines 22-39, col. 5, lines 48-61).

9. As to claim 3, Whitmarsh teaches wherein the system also comprises user interface means for selection by the user of the circumstantial constraint to be used in the ranking of the paths (col. 11, lines 22-58).

10. As to claim 5, Whitmarsh teaches wherein the processing devices are connected to each other by a local area network or the Internet (col. 3, lines 25-40).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**11. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Whitmarsh et al. (hereinafter Whitmarsh) (US 7,042,585 B1) in view of Nakajima (US 2002/0107817 A1).**

12. As to claim 4, Whitmarsh is silent in calculating the total price from the price attributes of services included in a determined path. However, Nakajima teaches a network printing system that has a summing means that calculates the total charge/price for printing services, for example ([0011]). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Whitmarsh's network printing system with Nakajima's network printing system so that it could be efficiently determined how much the customer needs to be charged ([0010]-[0011]).

***Response to Arguments***

13. Applicant's arguments have been fully considered but are moot in view of the new grounds of rejections.


***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kenneth Tang whose telephone number is (571) 272-3772. The examiner can normally be reached on 8:30AM - 6:00PM, Every other Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Meng-Ai An can be reached on (571) 272-3756. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Kt  
11/14/06

  
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